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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID D. FARALDO II

Appeal 2009-006183
Application 10/016,117
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY, III, and THU A. DANG, *Administrative Patent Judges.*

COURTENAY, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellant appeals under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1, 2, 7-10, 15-18, 23-26, 29, and 41-44. Claims 3-6, 11-14, 19-22, 27, 28, and 30-40 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We *pro forma* reverse the Examiner's rejections under §§ 102 and 103 and enter a new ground of rejection under 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

According to Appellant, the invention on appeal relates to "network administration and, in particular, to notification of state changes in a monitored system on a network." (Spec. 1, ¶ [0002]).

Exemplary Claim

1. A method, comprising:

enabling a standard notification rule to generate a first notification upon an occurrence of a predetermined event to a first person in a hierarchy, and

enabling an advanced notification rule to preempt the standard notification rule by suspending the first notification from being generated upon the occurrence such that the fist notification is not generated.

Prior Art

The Examiner relies on the following references as evidence:

Graf	US 5,619,656	Apr. 8, 1997
Rangarajan	US 5,987,514	Nov. 16, 1999

Examiner's Rejections

1. The Examiner rejected claims 1, 7-9, 15-17, 23-25, 29, and 41-44 under 35 U.S.C. § 102(e) as anticipated by Rangarajan.

2. The Examiner rejected claims 2, 10, 18, and 26 under 35 U.S.C. § 103(a) as unpatentable over Rangarajan and Graf.

NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b)

ISSUE

We do not reach the merits of the Examiner's anticipation and obviousness rejections because we find it necessary to first address the threshold issue of whether independent claims 1, 9, 17, and 25, (and associated dependent claims) are indefinite under 35 U.S.C. § 112, second paragraph.

PRINCIPLES OF LAW

Claim Construction

During prosecution, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

The USPTO is not required in the course of prosecution to interpret claims in the same manner as courts are required to during infringement

proceedings. "It would be inconsistent with the role assigned to the PTO in issuing a patent to require it to interpret claims in the same manner as judges who, post-issuance, operate under the assumption the patent is valid." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

35 U.S.C. § 112, Second Paragraph

The test for definiteness under 35 U.S.C. § 112, second paragraph, is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). *See also Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential), *available at* http://www.uspto.gov/web/offices/dcom/bpai/prec/fd073300.pdf.

A prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of the claim language. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

ANALYSIS

Claim 1

Based upon our review of Appellant's claim language when viewed in light of the Specification, we are unable to ascertain the scope of exemplary claim 1. In particular, we conclude that as constructed the "advance notification rule" renders the "standard notification rule" unnecessary because the standard notification rule can be preempted by the advanced notification rule, whether or not the standard notification rule is enabled. In

other words, it is unclear from the language of claim 1 when and how the first notification can be suspended from being generated upon the occurrence such that the first notification is not generated. Thus, we conclude it is unclear when and how the advanced notification rule is "enabled" (as claimed) to preempt the standard notification rule.

When we look to Appellant's Specification for *context and clarification*, we find little meaningful clarification, for example:

> In one embodiment, a network site monitoring system may be used to provide a means to proactively monitor a business site's services and resources. Various parameters of a host may be configured for monitoring for the occurrence of a predetermined event such as a state change or exceeding a threshold. Upon such occurrence, a notification may be sent to one or more appropriate persons designated by the business site. The notification system may notify the appropriate person for a number of times over a configurable amount of time using various communication means. If that person fails to respond, the system may escalate the notification to another person based on a set of escalation rules. The escalation rules determine who should be notified next in the event that a preceding recipient of a notification fails to respond to a notification with an acknowledgement.

(Spec. 6-7, ¶ [0025]).

Under § 112, second paragraph, claims must be "sufficiently definite such that those skilled in the art would understand what is being claimed when the claim is read in light of the Specification." *Ex parte Miyazaki*, 89 USPQ2d 1207 at 1211.

Because each independent claim on appeal similarly recites a nebulous indefinite relationship between the "standard notification rule" and the "advanced notification rule," it is our view that a person of ordinary skill

in the art would not have been able to reasonably ascertain the metes and bounds of the claimed invention. Moreover, it is our view that Appellant's Specification fails to set forth a definition of the recited notification rules and associated "enabling" with "reasonable, clarity, deliberateness, and precision" that would render the incorporation of such definition into the claims appropriate (*quoting In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994)).

Our observations here essentially mirror and reinforce the Examiner's comments as set forth on page 8 of the Answer (1st full paragraph), although the Examiner did not reject the claims under § 112. Since the prior art rejections cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of the claim language, a material issue of claim interpretation is present which must be resolved before the merits of the Examiner's and Appellant's positions can be properly considered. *See In re Steele*, 305 F.2d at 862-63.

Therefore, we *pro forma* reverse the Examiner's rejection of independent claims 1, 9, 17, and 25, and all claims which depend therefrom that stand rejected under 35 U.S.C. §§ 102(e) and 103(a).

CONCLUSION OF LAW

We conclude that claims 1, 2, 7-10, 15-18, 23-26, 29, and 41-44 are indefinite under 35 U.S.C. § 112, second paragraph.

DECISION

We *pro forma* reverse the Examiner's rejections of claims 1, 7-9, 15-17, 23-25, 29, and 41-44 under 35 U.S.C. § 102(e) and claims 2, 10, 18, and

26 under 35 U.S.C. § 103(a) and enter a new ground of rejection for claims 1, 2, 7-10, 15-18, 23-26, 29, and 41-44 under 35 U.S.C. § 112, second paragraph.

37 C.F.R. § 41.50(b) provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record . . . .

ORDER

REVERSED
37 C.F.R. § 41.50(b)

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